

REMARKS/ARGUMENT

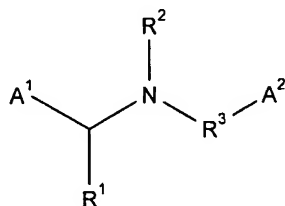
This response is submitted under 37 C.F.R. § 1.111 to the Office Action of October 6, 2008.

Claims 2, 4, 6, 8, 9, and 12 through 22 are pending in the application. Claims 16 and 22 are amended, and claims 1, 3, 5, 7, 10, and 11 are canceled. No fee is due.

1. Rejection under 35 U.S.C. § 103(a)

Claims 2, 4, 6, 8, 9, 13 through 15, and 17 through 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moloney et al. (WO99/42447). The Applicants traverse this rejection and request reconsideration.

Moloney et al. disclose compounds of formula (I)



and salts thereof as phytopathogenic fungicides, wherein A¹ is substituted 2-pyridyl; A² is optionally substituted phenyl; R³ is -(C=O)-, -SO₂- or -(C=S)-; R¹ is hydrogen, optionally substituted alkyl or acyl; and R² is hydrogen or optionally substituted alkyl, are useful phytopathogenic fungicides.

The Examiner has stated in both the previous and the current Office Actions:

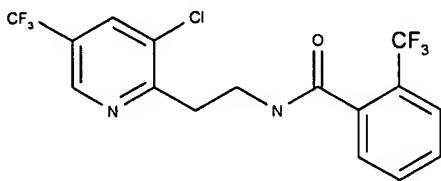
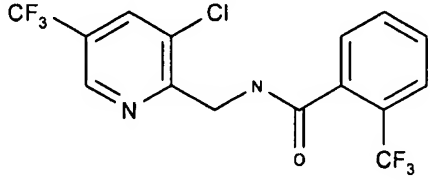
The difference between the prior art compound and the instantly claimed compound is the alkylene group between the pyridyl group and the benzamide

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moiety. In the instant compound, alkylene group is ethylene. In the prior art compound, alkylene group is a methylene group. The prior art compound and the instant compound are homologues of each other. Homologues are compounds that differ by a methylene linkage. Here, the Moloney compounds are also fungicides as are the instant compounds. See line 4 of page 2.

It would have been obvious to one of ordinary skill in the art to synthesize homologues of this class of compounds and compositions. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

Accordingly, in the response to the previous office action, the Applicants submitted the following experimental data to show unexpected results that demonstrate the benefits in terms of fungicidal activity of an ethylene group linking the pyridyl and benzamide moiety with each other, rather than a methylene group.

Compound		<i>Botrytis cinerea</i>	<i>Alternaria brassicae</i>
According to the invention		Good to very good activity (80-100%) at 330 ppm	Good to very good activity (80-100%) at 330 ppm
Compound 1 of U.S. 6,503,933 (Moloney et al.)		No activity at 330 ppm	No activity at 330 ppm

The Applicants reiterate that this finding would have been surprising to the person of ordinary skill in the art and would not have been rendered obvious by the cited reference.

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In the current Office Action, the Examiner stated:

The applicant presents evidence of alleged nonobviousness and unexpected results of the claimed compounds over the prior art compounds in the remarks. However, according to 37 CFR 1.132, when any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section. Here, since the claims 2, 4, 6, 8-9, 13, 14, 15, 7-21 were rejected under 103 (a), and the evidence provided was not originally provided in the specification or anywhere else in the application, this evidence must be submitted by way of oath or a declaration.

A declaration verifying the above-described experimental evidence will follow the submission of this amendment.

It is therefore requested that the rejection of claims 2, 4, 6, 8, 9, 13 through 15, and 17 through 21 under 35 U.S.C. § 103(a) as being unpatentable over Maloney et al. be withdrawn.

2. Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 12 and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter that the Applicants regard as the invention. Specifically, according to the Examiner:

1. Regarding claims 12 and 22, the phrase ‘depending on whether or not the medium is acid’ renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP §2173.05(d).
2. Claim 16 recites the limitation ‘X’ in line 4, page 6. There is insufficient antecedent basis for this limitation in the claim.

The phrase “depending on whether or not the medium is acid” is deleted from claim 12, directly, and claim 22, indirectly.

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It is not clear whether claim 16 is rejected under 35 U.S.C. § 103(a) or whether there is an objection to it. Notwithstanding, claim 16 is amended by changing "at least one X is a haloalkyl" to -- at least one of X¹ and X² is a haloalkyl --.

Accordingly, it is requested that the rejection of claims 12 and 22 and possibly claim 16 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In view of the foregoing, it is submitted that this application is now in condition for allowance, and an early office action to that end is earnestly solicited.

Respectfully submitted,

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Date



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